

Application Number 10/731,699
Responsive to Office Action mailed May 18, 2007

REMARKS

This Amendment is in response to the Office Action dated May 18, 2007. Applicant has amended claims 7 and 25. Claims 1, 3-15 and 17-25 are pending.

Claim Rejection Under 35 U.S.C. § 102

Claim 25

The Office Action rejected claim 25 under 35 U.S.C. § 102(b) as being anticipated by Lynch (US 4,934,368). Applicant respectfully traverses the rejection. Lynch fails to disclose or suggest each and every feature of the claimed invention, as required by 35 U.S.C. § 102(b), and provides no teaching that would have suggested the desirability of modification to include such features.

In the rejection of claim 25, the Office Action cites implant case 12 as being equivalent to the first module and nerve cuff 2 as being equivalent to the second module as recited in claim 25. The Office Action also cites lead 3 as being equivalent to the coupling module as recited in claim 25.

However, in contrast to the coupling module recited in claim 25 of claim 25, lead 3 does not define at least one lumen between the first and second housings. Lynch otherwise fails to disclose or suggest a coupling module that defines at least one lumen between the first and second housings as claimed. The Office Action clearly fails to account for this feature. In the event that the Examiner maintains the current rejection, Applicant respectfully requests clarification in this regard.

Furthermore, the Office Action fails to cite any support for the contention that lead 3 is inherently hermetically sealed to both housings with using silicone rubber. As set out in MPEP 2112 (IV), the Office Action, "must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art."¹ In this case, because the Office Action fails to disclose any reasoning to support the finding of inherency, the current rejection fails to meet this standard.

¹ *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990).

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Additionally, because Lynch describes master circuitry case 8 as being hermetically sealed, but not leads 3 or implant case 12,² it appears that the connection between leads 3 and implant case 12 is not necessarily hermetically sealed. For example, if implant case 12 were hermetically sealed, then it would not be necessary that implant case 12 also be hermetically sealed.

Lynch fails to disclose each and every element of claim 25. For at least these reasons, the Office Action fails to establish a prima facie case for anticipation of Applicant's claims 25 under 35 U.S.C. §102(b). Withdrawal of this rejection is requested.

Claims 7-11, 14, 15 and 20-23

The Office Action rejected claims 7-11, 14, 15 and 20-23 under 35 U.S.C. § 102(b) as being anticipated by Gorcik (US 3,720,874). Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the claims as amended. Gorcik fails to disclose or suggest each and every feature of the claimed invention, as required by 35 U.S.C. §102 (b), and provides no teaching that would have suggested the desirability of modification to include such features.

For example, with respect to independent claim 7 as amended, Gorcik fails to disclose or suggest the feature of wherein the coupling module is hermetically fixed to the first and second housings.

As another example, with respect to independent claim 7 as amended, Gorcik fails to disclose or suggest an implantable medical device.

Gorcik fails to disclose each and every element of claim 7. Dependent claims 8-11, 14, 15 and 20-23 are patentable for at least the reasons claim 7 is patentable. For at least these reasons, the Office Action fails to establish a prima facie case for anticipation of claims 7-11, 14, 15 and 20-23 under 35 U.S.C. §102(b). Withdrawal of this rejection is requested.

² Lynch, FIG. 2 and column 6, lines 15-25.

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Claim Rejection Under 35 U.S.C. § 103

Claims 1, 3-6 and 24

The Office Action rejected claims 1, 3-6 and 24 under 35 U.S.C. §103(a) as being unpatentable over Lynch (US 4,934,368). Applicant respectfully traverses the rejection. The applied reference fails to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

Lynch fails to teach or suggest an implantable medical device comprising at least two modules, each of the modules comprising a respective one of at least two housings, a coupling module coupled to each of the modules, the coupling module defining at least one lumen between the housings, and an overmold that at least partially encapsulates each of the housings and the coupling module, wherein the coupling module permits motion of the two modules along at least one axis of motion.

In the rejection of claim 1 the Office Action admits that Lynch fails to teach an overmold as recited in claim 1. However, the Office Action argued that it would be obvious to coat both the case 12 and the lead 3 with a dip coating of silicone because Lynch teaches the layer of soft silicon 25 is applied after the lead and the case have been assembled and because a dip coating is also an after an assembly process. For reference, a portion of Lynch that discusses silicon 25 is shown below.

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At the point where the leads 3 enter the case 12, a layer of soft silicone rubber 25 is applied to absorb any lateral strain on the leads 3. This layer of soft silicone 25 is applied after the case 12 and leads 3 have been assembled and can be removed, for example, by cutting, if a lead 3 needs to be replaced.

In contrast to the argument in the Office Action, Lynch fails to disclose or suggest a "dip coating". In fact, the Office Action fails to provide any reasoning whatsoever as to why one of ordinary skill in the art would find it obvious to modify silicon 25 other than to say that, "a dip coating is also an after an assembly process". Lynch fails to provide any reason to include more silicon than that shown in FIG. 3. In fact, Lynch teaches a benefit of silicon 25 that may not be the same with a dip coating— the benefit that silicon 25 can be removed if a lead 3 needs to be

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replaced. In contrast, a dip coating of silicon may be more difficult to remove than silicon 25, which could make it more difficult to replace a lead.

In this manner, Lynch fails to disclose or suggest Applicant's invention as recited in claim 1. Dependent claims 3-6 and 24 are patentable for at least the reasons claim 1 is patentable. For at least these reasons, the Office Action fails to establish a prima facie case for non-patentability of Applicant's claims 1, 3-6 and 24 under 35 U.S.C. § 103(a). Withdrawal of this rejection is requested.

Claims 12, 13 and 17-19

The Office Action rejected claims 12, 13 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over Gorcik. Applicant respectfully traverses the rejection to the extent such rejection may be considered applicable to the claims as amended. The applied reference fails to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

For example, with respect to independent claim 7 as amended, Gorcik fails to disclose or suggest the feature of wherein the coupling module is hermetically fixed to the first and second housings. Claims 12, 13 and 17-19 are dependent on claim 7. In light of the obvious differences between claim 7 as amended, Applicant reserves comment with respect to dependent claims 12, 13 and 17-19.

For at least these reasons, the Office Action fails to establish a prima facie case for anticipation of claims 12, 13 and 17-19 under 35 U.S.C. §102(b). Withdrawal of this rejection is requested.

Rejection for Obviousness-type Double Patenting

The Office Action rejected claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending US Pat. No. 7,212,864.

Applicant respectfully traverses this rejection. Applicant respectfully submits that the Office Action has not established a prima facie case of obviousness-type double patenting. To support an obviousness-type double patenting rejection, the Office Action must assess the

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differences between the claims in the pending application and the claims in the issued patent.³ In particular, the Office Action should indicate why the claims in an application are obvious over the claims in the granted patent.⁴

The Office Action stated that the application and patent claims are not patentably distinct "because the two modules of the claimed invention possess an identical housing to that of the [issued patent]." Proper analysis employed in an obviousness-type double patenting rejection is the same as analysis for a 35 U.S.C. §103 obviousness determination.⁵ Therefore, all of the claimed features recited by claim 1, in combination, must be obvious in view of claim 1 of US Pat. No. 7,212,864.

In contrast to the present invention as recited in claim 1, claim 1 of US Pat. No. 7,212,864 does not include or suggest, "a coupling module coupled to each of the modules, the coupling module defining at least one lumen between the housings," as recited in claim 1 of the present application. Because each of the features of claim 1 are not obvious in view of claim 1 of US Pat. No. 7,212,864, Applicant respectfully requests the Examiner withdraw this rejection.

³ *In re Berg*, 46 USPQ2d 1226, 1229 (Fed Cir. 1998).

⁴ *Id.*

⁵ *In re Braat*, 937 F.2d 589, 19 USPQ2d 1289 (Fed. Cir. 1991); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985), as cited in MPEP 804.

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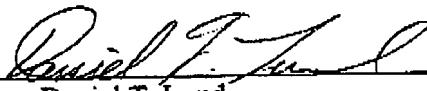
CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

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August 16, 2007
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